

REMARKS

Claims 16-17 and 20-26 were pending in this application.

Responsive to the examiner's comments, applicants propose to amend claim 16 in order to more particularly point out and distinctly claim a preferred aspect of their invention. Thus, applicants propose to incorporate the limits of claim 17 into claim 16. Since claim 17 fails to further limit amended claim 1, applicants propose to cancel it.

Applicants further propose to limit the body-care and household products to those which are stored in a translucent container and are subject to photolytic degradation. This claim amendment is supported by the disclosure on page 1, first two paragraphs. Obviously body-care and household products that were in opaque containers would not be subject to photolytic degradation during storage.

Applicants further propose to require that the light stabilizer be present in a concentration from 50 to 1000 ppm. This claim amendment is supported by the disclosure on page 24, last full last paragraph and by the exemplification.

No new matter has been added by any of these amendments. Since the amendment places the claims in condition for allowance and will require no new search, its entry is respectfully solicited.

The claims have been amended in accord with the current rules in which underlining shows additions and deletions are shown by strikethrough.

Claims 16, 17, 20, 21, 24 and 26 are finally rejected under 35 U.S.C. § 102(a) as being anticipated by Luther et al. (commonly assigned US Patent 6,090,370).

Luther et al discloses selected benzotriazole derivatives that are useful for the UV protection of human hair. Luther teaches at col. 7, lines 27ff:

It is preferred to use cosmetic formulations for hair comprising, as UV absorber, a benzotriazole compound of formula (1), triethylene glycol butyl ether and tributyl citrate.

Of these formulations, those are very particularly preferred wherein the UV absorber is a benzotriazole compound of formula (4).

These last-mentioned formulations preferably comprise

25 to 50 parts of the benzotriazole compound of formula (1), preferably of formula (4),  
40 to 80 parts of triethylene glycol butyl ether, and  
0.5 to 5 parts of tributyl citrate.

In contrast thereto, the UV absorbers are used in the present invention at a much lower concentration of 50 to 1000 ppm as claimed in claim 16, i.e. at a maximum of 0.1 parts. Said lower concentrations are neither taught nor suggested in Luther.

Reconsideration and withdrawal of the rejection of claims 16, 20, 21, 24 and 26 under 35 U.S.C. § 102(a) as being anticipated by Luther, US Patent 6,090,370 is respectfully solicited in light of the remarks *supra*.

Claims 16, 20-23, 25 and 26 are finally rejected under 35 U.S.C. § 102(b) as being anticipated by Dümller et al. (GB 2,286,774). Dümller et al. disclose certain sunscreen compositions comprising micronized, insoluble organic UV absorbers, wherein the UV absorber particles have a mean particle size of 0.05 to 1.5  $\mu\text{m}$ . The reference also discloses cosmetic compositions comprising several percent by weight of these micronized, insoluble organic UV absorber derivatives.

The proper test for anticipation is whether the instant claims read on the actual compositions and/or methods shown in the reference, not whether there is overlap between a generic scope and the claimed invention. Quite clearly the instant claims do not read on the actual compositions and/or methods shown in the reference. Hence there is no anticipation.

Moreover, because the cosmetic compositions contain micronized, insoluble organic UV absorber derivatives, they would be opaque. An opaque formulation would not be subject to photolytic degradation as required by claim 16, even if stored in translucent containers, since light cannot pass through the formulation.

Reconsideration and withdrawal of the rejection of claims 16, 20-23, 25 and 26 under 35 U.S.C. § 102(b) as being anticipated by Dümller et al. (GB 2,286,774) is respectfully solicited in light of the remarks *supra*.

Claims 16, 20-22, 24 and 25 are finally rejected under 35 U.S.C. § 102(b) as being anticipated by Strobel I (US Patent 3,983,132). Strobel discloses stabilization compositions particularly adapted to

prevent deterioration resulting from exposure to heat and light in polymeric materials, paints and dyes, which consist of a specific mixture of isomeric benzotriazole derivatives. This specific benzotriazole UV absorber is an isomeric mixture of 2-(5'-dodecyl-2'-hydroxyphenyl)benzotriazoles, which is very different from the claimed benzotriazoles of formula (3).

The reference is seen to teach away from the present invention as it clearly states in col. 1, lines 48ff:

Similar difficulties are encountered with triazoles containing polar substituents such as SO<sub>2</sub>NH<sub>2</sub>, amine derivatives thereof, SO<sub>3</sub>Na, COONa, etc. Additionally, in the case of the lower alkyl benzotriazoles, the lower alkyl substituents are known to be incompatible with high molecular weight hydrocarbon type polymers...

Thus, quite clearly Strobel teaches away from use of the benzotriazoles of formula (3), which contain both a lower alkyl substituent and a polar SO<sub>3</sub>Na substituent.

Reconsideration and withdrawal of the rejection of claims 16, 20-22, 24 and 25 under 35 U.S.C. § 102(b) as being anticipated by Strobel (US Patent 3,983,132) is respectfully solicited in light of the remarks *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 16 and 20-26 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



Kevin T. Mansfield  
Agent for Applicants  
Reg. No. 31,635

Ciba Specialty Chemicals Corporation  
540 White Plains Road  
Tarrytown, New York 10591  
(914) 785-7127  
KTM21868A3

Enclosure: Petition for Extension of Time

SEP 24 2003

09/830,788

- 7 -

HP/5-21868/US/A/PCT